THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte CECIL O. MORSE
and HAROLD S. NUTT

_____

Appeal No. 99-0196
Application 08/270,742[1]

_____

ON BRIEF

_____

Before COHEN, FRANKFORT and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Cecil O. Morse et al. appeal from the final rejection of claims 1 through 5, 10 and 11, all of the claims pending in the application. We reverse.

The invention relates to a method for retrofitting a

[1] Application for patent filed July 5, 1994.

chiller system. Claim 1 is representative and reads as follows:

1. A method of retrofitting a chiller system of the type having a condenser, cooler, compressor interconnected and operating on a vapor compression cycle and in which cooling water is supplied to the condenser and returned to a cooling tower, said method comprising:

(a) disconnecting the cooling water supply to the condenser from said cooling tower; and

(b) re-connecting said condenser to a cooling water supply from an existing in-place water supply dedicated for another use whereby cooling water is supplied to the condenser and returned to the water supply.

The item relied upon by the examiner as evidence of obviousness is:

Lawrence et al. (Lawrence) 4,538,418 Sep. 3, 1985

The item relied upon by the appellants as evidence of non-obviousness is:

The 37 CFR § 1.132 Declaration of David L. Yoder filed on May 3, 1996 (Paper No. 9).

Claims 1 through 5, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawrence.

Reference is made to the appellants' brief (Paper No. 15) and to the examiner's answer (Paper No. 16) for the respective

positions of the appellants and the examiner with regard to the merits of this rejection.

Lawrence discloses a heat pump system 10. As described in the reference,

> [h]eat pump system 10 includes a fluid refrigerant compressor 12 and two heat exchanger units 14 and 16. Heat exchanger unit 14 functions as a condenser in the heating mode and as an evaporator in the cooling mode of heat pump system 10 to heat or cool an air space 18. Heat exchanger unit 16 functions as an evaporator in the heating mode of operation and as a condenser in the cooling mode of operation of heat pump system 10 for receiving heat or transferring heat to water circulating through heat exchanger unit 16.
>
> Water is supplied to heat exchanger unit 16 from a water source 20. An important aspect of the present invention is that water source 20 is provided from a city, town or development water main. The water is then returned directly into water source 20 with no contamination or reduction in volume taking place. Also, water source 20 may comprise, for example, a well, stream or a body of water such as an ocean or lake. Additionally, water source 20 may comprise a closed system such as an above ground or underground water storage tank or underground piping loop system [column 3, lines 5 through 26].

As conceded by the examiner (see page 3 in the answer), Lawrence does not meet the "retrofitting" limitations in claim 1 which require the steps of disconnecting the cooling water supply to the condenser from a cooling tower and connecting

the condenser to a cooling water supply from an existing in-place water supply dedicated for another use. In this regard, Lawrence makes no mention of retrofitting or of a cooling tower. The examiner's conclusion that Lawrence nevertheless would have rendered the retrofitting method recited in claim 1 obvious within the meaning of 35 U.S.C. § 103 (see pages 3 and 4 in the answer) is not well taken.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

In the present case, the examiner has failed to advance any factual basis to support a conclusion that the foregoing differences between the subject matter recited in claim 1 and Lawrence are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Instead, the

examiner has improperly relied on speculation, unfounded assumptions and/or hindsight reconstruction to supply the deficiencies in Lawrence. As a result of its shortcomings, the Lawrence reference fails to establish a prima facie case of obviousness with respect to the subject matter recited in claim 1 or in claims 2 through 5, 10 and 11 which depend therefrom.[2] Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of these claims.

The decision of the examiner is reversed.

REVERSED

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IRWIN CHARLES COHEN)
Administrative Patent Judge)
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[2] This being so, we find it unnecessary to evaluate the merits of the appellants' declaration evidence of non-obviousness.

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	) BOARD OF PATENT
CHARLES E. FRANKFORT	)
Administrative Patent Judge	) APPEALS AND
	)
	) INTERFERENCES
	)
JOHN P. McQUADE	)
Administrative Patent Judge	)

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JPM/caw